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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,417	09/30/2003	Masahiro Yamanaka	SIC-02-009-1	8051
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DELAND LAW OFFICE P.O. BOX 69 KLAMATH RIVER, CA 96050-0069			EXAMINER LUONG, VINH	
			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/676,417
Filing Date: September 30, 2003
Appellant(s): YAMANAKA, MASAHIRO

James A. Deland
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 12, 2006 appealing from the Office action mailed July 15, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of claimed subject matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of rejection to be reviewed on appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal in the brief is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence relied upon in the rejection of claims under appeal.

356,497	Ernest (United Kingdom)	09-1931
5,845,543	Yamanaka	12-1998

(9) Grounds of rejection

The following grounds of rejection are applicable to the appealed claims:

(a) Claims 35, 36, and 38-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Ernest; and

(b) Claims 46-56 are rejected under 35 U.S.C. 103(a) as being obvious over Ernest in view of Yamanaka.

The above rejections are set forth in the final rejection on July 15, 2005.

(10) Response to argument

The Examiner's response to Appellant's arguments in the final rejection on July 15, 2005 is incorporated herein by reference. In the following, the Examiner addresses Appellant's arguments that have not been responded in the final rejection.

Appellant contended:

It is respectfully submitted that there is no basis to conclude that even the end (3) of Ernest's axle (1) could be inserted into the opening (18) in crank arm (17) because the flats (4) at end (3) are shallower than the flats (15) that are dimensioned to be inserted into opening (18) in crank arm (17). In any event, there is no way that the cylindrical portions of axle (1) directly to the right of flats (4) could pass through opening (18) in crank arm (17). Accordingly, Ernest neither discloses nor suggests the subject matter recited in claim 35 and the corresponding dependent claims.

Ernest does not state anywhere in the reference that the crank arm 17 abuts against the projection 16. However, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference is/are nonetheless inherent in it. See *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principle of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986).

In the instant case, albeit Ernest's Fig. 3 shows that the cylindrical portions of axle 1 could not pass through the opening 18, 19 in the crank arm 17, however, Figs. 1 and 3 show that

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the flat 15 of the crank arm 17 could pass the opening 17, 19. Therefore, the user can mount the axle 1 to the crank arm 17 by performing, *e.g.*, the following steps:

(a) deletion or eliminating the washer 20;

(b) passing the flats 15 of the axle 1 through the aperture 18, 19 of the crank arm 17; and

(c) bending the flats 15 to form the projections 16 as shown in Fig. 1.

The above steps are described in lines 10-26 on page 3 of Ernest except the step of deleting the washer. In other words, Appellant's invention is substantially identical to Ernest's invention with an exception that Applicant does not use the washer. It is note worthy that Ernest's bicycle crank axle 1 is still operative even without the washer 20.

On the other hand, one may reasonably interpret that the washer 20 is a part of the crank arm 17. In this case, the projections 16 are abutted against the crank arm that comprises elements 17 and 20. The washer as part of the crank arm is notoriously well known as evidenced by, *e.g.*, the washer 56 and the crank arm 1 in Fig. 8 of Yamanaka.

Notwithstanding the above factual analysis, it is well settled that anticipation law requires distinction be made between invention described or taught and invention claimed. It does not require that the reference "teach" what subject patent application teaches, it is only necessary that the claim under attack, as construed by the Court, "*read on*" something disclosed in the reference, *i.e.*, all limitations of the claim are found in reference, or are "*fully met*" by it. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781, 789 (CAFC 1983).

In the instant case, Ernest's Fig. 1 shows that the projections 20 are *indirectly* abutted against the crank arm 17. Applicant's independent claim 35 does *not* specifically require that the

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projections must be *directly* abutted against the crank arm 17. Therefore, Ernest's projections "read on" Applicant's claim because the claim does not preclude the embodiment that has the projections being indirectly abutted against the crank arm.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's answer.

CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Vinh T. Luong
Primary Examiner

Conferees on March 2, 2006

SPE Richard Ridley



Primary Examiner Kim Chong



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